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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,975	01/26/2001	Frank DeMartin	450103-3873.1	8006

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EXAMINER
VAUGHN JR, WILLIAM C

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *23 August 2004*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *13,14,16-18 and 20-23* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *13,14,16-18 and 20-23* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some *   c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date *12/06/04*.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

1.   This Action is in regards to the Amendment and Response received on 30 August 2004 as

well as the IDS received on 06 December 2004.

Response to Arguments

2.   Applicant's arguments and amendments filed on 30 August 2004 have been carefully

considered but they are not deemed fully persuasive. Applicant's arguments are deemed moot in

view of the following new grounds of rejection as explained here below, necessitated by

Applicant's substantial amendment (i.e., *by processing contents data of each medium...located*

at the first equipment location...) to the claims which significantly affected the scope thereof.

Information Disclosure Statement

3.   The references listed in the Information Disclosure Statement submitted on 06 December

2004, have been considered by the examiner (see attached PTO-1449).

4.   The application has been examined. **Claims 13, 14, 16-18, 20-23** are pending. The

Examiner further acknowledges the cancellation of claims 15 and 19. The objections and

rejections cited are as stated below:

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   **Claims 13-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cluts, U.S.

Patent No- 5,616,876 in view of Atcheson et al. (Atcheson), U.S. Patent No. 5,583,763 and

further in view of Schiller et al. (Schiller), U.S. Patent No. 5,499,046.

7.   Regarding independent claims 13 and 17, (e.g., exemplary independent claim 13), Cluts

discloses the invention substantially as claimed. Cluts discloses a system for accessing, over a

wide area network, multimedia equipment for reproducing multimedia information recorded on

data storage media, comprising: (Cluts teaches using a distribution network that includes a world

wide ATM compatible network with links to the Internet in addition to the distributed network

being implemented as a hybrid network environment as well as teaching a consumer system that

includes the equipment necessary to receive program information), [see Cluts, Col. 6, lines

29-33, Col. 6, lines 20-37 and Col. 8, lines 5-8], generating means for generating a list of

contents of multimedia information recorded on data storage media of a first user at a first

equipment location by processing contents data of each medium I the data storage media at the

first equipment location (Cluts teaches a playlist that is generated for the subscriber by the

service provider or a publisher. Further Cluts also teaches one or more memory storages devices

connected to the storage servers as well as being able to replicate the digitized data a within the

CMS system. Also, Cluts teaches that programming modules as well as selected programming

information is transmitted across the distribution network to the subscriber), [see Cluts, Fig. 4,

Col. 7, lines 1-28, Col. 11, lines 7-12, Col. 12, lines 40-64], (Thus it is obvious that the

information would include the playlist in order for the subscriber to select certain songs from a

playlist); converting means for converting the rearranged list of contents to at least one command

for controlling the multimedia equipment [see Cluts, Fig. 10, steps 1025-1030, Col. 8, lines 45-

53] and a controlling means for controlling the multimedia equipment based on said one

command (Cluts teaches this at step 1030). However, Cluts does not disclose the list of contents

being generated by a first user and transferred via said wide area network to a second user at a

second equipment location, said second user modifying the generated list of contents by and

rearranging selecting items to produce a rearranged list of contents.

8.   In the same field of endeavor, Atcheson discloses (e.g., selection base multiuser system).

Atcheson discloses said generating means operating to transfer said list of contents being

generated by a first user and transferred via said wide area network and then modifies the

generated list of contents by selecting items from said list of contents and arranging the selected

items in a predetermined order to produce a modified list of contents (Atcheson teaches the user

is given a menu of choices for proceeding within the service and one of the option is for the user

to define "preferences", or a list of their favorite artists. Atcheson also teaches ranking the

generated recommendations of music for any one of the user in which a search of the database of

the same of objects from different users. And each match will generate one object that was not

listed by the subject and then a calculation is made of the total number of occurrences from each

such object and create two rank tables and then a comparison is made of the rankings between

the first and second tables and which is used to create a third table and by using the weighted

averages of the searches a final table is made of those subjects ranging from most likely to enjoy

to least likely to enjoy), [see Atcheson, Col. 4, lines 5-12, 56-67, Col. 5, lines 25-67 and Col. 6,

lures 1-6].

9.   Accordingly, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to have combined Atcheson's multi-user system with the system of Cluts for

the purpose of the user to make a selection from a large collection of digital objects by

generating a selection of information for the network, [see Atcheson, Col. 1, lines 50-55].

However, Cluts-Atcheson does not explicitly disclose a second user modifying the generated list.

10.   In the same field of endeavor, Schiller discloses (e.g., CATV distribution system).

Schiller discloses a second user modifying the generated list (Schiller teaches the generating,

editing and modifying of a playlist. Schiller also teaches that each channel scheduler is in

communication with both headends which broadcast their particular channels and that each

scheduler while in communication with the headends allow operators or application software at

different stations to update headends with respect to new or modified scheduling information

corresponding to their respective channels), [see Schiller, Abstract, Col. 2, lines 19-50, Col. 3,

lines 64-67, Col. 4, lines 1-67 and Col. 5, lines 1-31].

11.   Accordingly, it would have been obvious to one having ordinary skill in the art at the

tune the invention was made to have incorporated Schiller's teachings of CATV distribution

system with the teachings of Cluts-Atcheson, for the purpose of allowing different companies

controlling the output of particular CATV channels to generate, edit, and modify the playlist

schedules of their respective channels from locations of their choosing [see Schiller, Col. 1, lines

60-67). By this rationale claim 13 is rejected.

12.   Regarding claim 14, Cluts-Atcheson and Schiller discloses a server [see Cluts, Fig. 1] for

providing a user interface for requesting the list of content to be modified (Atcheson teaches

given the user the opportunity to modify the list of their favorite artist by using the buttons on

their telephone or by operating the keyboard or mouse or other input device on their computer),

[see Atcheson, Col. 4, lines 13-19] and said server operative to transfer the list of contents over

the wide area network to the .second user at the second equipment locating, (Cluts teaches that a

CMS system includes one or more storage servers, which operates to retrieve and to transmit the

digitized data as required by clients of the CN15 system), [see Cluts, Col. 6, lines 30-67, Col. 7,

lines 67 and Col. 12, lines 61-65], (Cluts further teaches a method of searching for and matching

the entries in the audio content database based upon a "style slider" indicator), [see Cluts, Col.

16, lines 1-10]. The same motivation that was utilized in claim 13 applies equally as well to

claim 14. By this rationale claim 14 is rejected.

13.   Regarding claim 15, Cluts-Atcheson and Schiller further discloses the list of contents is

generated on the basis of data uniquely identifying the contents of each data storage medium in

the data storage media (Cluts teaches a plurality of programming information items stored in a

data storage device), [see Cluts, Col. 15, lines 14-18 and Col. 26, lines 47-50]. By this rationale

claim 15 is rejected.

14.   Regarding claim 16, Cluts-Atcheson and Schiller discloses further comprising a server

operative to transmit the generated list of contents to the second user, receive the rearranged list

from the second user, form a command script file based on the rearranged list, and transmit the

command script file to the multimedia equipment of the first user which parses the command

script file to obtain a series of control commands to control the multimedia equipment (The

Examiner takes Official Notice (see MPEP 2144.03)). By this rationale claim 16 is rejected.

15.   Claims 17-20 list all the same elements of claims 13-16, but in method form rather than

system form. Therefore, the supporting rationale of the rejection to claims 13-16 applies equally

as well to claims 17-20.

Response to Arguments

16.   Applicant's Request for Reconsideration filed on 130August 2004 has been carefully

considered but is not deemed fully persuasive. However, because there exists the likelihood of

future presentation of this argument, the Examiner thinks that it is prudent to address Applicants'

main points of contention.

> A. Applicant argues that Cluts fails to teach or suggest a system including a generating
>
> means, which generates a list of contents of multimedia information by processing data of
>
> each medium in the data storage media at the first equipment location and which transfers
>
> the list of contents to a second user to produce a rearranged list of contents.
>
> B. Applicant argues that there is no second user that modifies a generated list of a first
>
> user by rearranging its contents.

17.   As to "Point A", it is the position of the examiner that in combination Cluts-Atcheson and

Schiller do in fact teach generating a list as well as modifying the list and thus rearranging that

modified list. The Examiner would also like to bring to Applicant's attention that nowhere

within the claims does in identify whether the server, client or first or second user generates the

list.

18.   As to "Point B", it is the position that in combination of Cluts-Atcheson and Schiller does

in fact teach a second user modifying a generated list of another user by rearranging contents

[see Schiller, Col. 2, lines 24-49].

19.   As to Applicant's argument regarding Foladore and Duso. Applicant's argument's

overcome the rejection.

20.   Again, it is the Examiner's position that Applicant has not yet submitted claims drawn to

limitations, which define the operation and apparatus of Applicant's disclosed invention in

manner, which distinguishes over the prior art. As it is Applicant's right to continue to claim as

broadly as possible their invention. It is also the Examiner's right to continue to interpret the

claim language as broadly as possible. It is the Examiner's position that the detailed

functionality that allows for Applicant's invention to overcome the prior art used in the rejection,

fails to differentiate in detail how these features are unique. As it is extremely well known in the

networking art as already shown by Cluts-Atcheson and Schiller and other prior arts of records

disclosed, a generating means, which generates a list of contents of multimedia information by

processing data of each medium in the data storage media at the first equipment location and

which transfers the list of contents to a second user to produce a rearranged list of contents as

well as other claimed features of Applicant's invention. It is recommended that Applicant,

further clarify how the command script is formed based upon the rearranged list and the parsing

of the script in order to obtain the different commands. It is also the position of the Examiner

that the second user and the server could possibly be incorporated into one system. Thus, it is

clear that Applicant must submit amendments to the claims in order to distinguish over the prior

art use in the rejection that discloses different features of Applicant's claim invention. Also, IDS

reference Atcheson, 0643359, further teaches modification of a list originally received by a

server and sent to a user.

21.   Applicant employs broad language, which includes the use of word, and phrases, which

have broad meanings in the art (i.e., contents). In addition, Applicant has not argued any

narrower interpretation of the claim language, nor amended the claims significantly enough to

construe a narrower meaning to the limitations. As the claims breadth allows multiple

interpretations and meanings, which are broader than Applicant's disclosure, the Examiner is

forced to interpret the claim limitations as broadly and as reasonably possible, in determining

patentability of the disclosed invention. Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See In re Van

Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993).

22.   Failure for Applicant to significantly narrow definition/scope of the claims and supply

arguments commensurate in scope with the claims implies the Applicant intends broad

interpretation be given to the claims. The Examiner has interpreted the claims with scope

parallel to the Applicant in the response, and reiterates the need for the Applicant to more clearly

and distinctly, define the claimed invention.

Conclusion

23.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

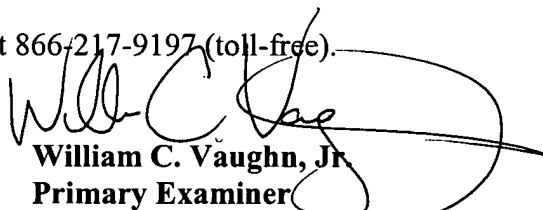CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to William C. Vaughn, Jr. whose telephone number is (571) 272-

3922. The examiner can normally be reached on 8:00-6:00, 1st and 2nd Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

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William C. Vaughn, Jr.
Primary Examiner
Art Unit 2143

WCV